



Paper No. 7

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**COPY MAILED**

**MAR 19 2002**

**OFFICE OF PETITIONS**

In re Application of :  
Keith, Little, Van Eerdewegh, :  
Dupuis, Del Mastro, Simon, Allen, : DECISION REFUSING STATUS  
and Pandit : UNDER 37 CFR 1.47(a)  
Application No. 09/834,597 :  
Filed: 13 April, 2001 :  
Attorney Docket No. 2976-4039US1 :  
:

This is in response to the petition filed under 37 CFR 1.47(a)<sup>1</sup> on 26 November, 2001.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

**FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.**  
Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 13 April, 2001, without an executed oath or declaration. Accordingly, on 25

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<sup>1</sup>A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee; and
- (4) a statement of the last known address of the non-signing inventor.

June, 2001, Initial Patent Examination Division mailed a Notice to File Missing Parts of Application, requiring a signed oath or declaration and a surcharge for its late filing. In response, on 26 November, 2001,<sup>2</sup> petitioners filed the present petition with authorization to charge the petition fee, the late filing surcharge, a three (3) month extension of time, basic filing fee, the late filing surcharge, a two (2) month time extension, the present petition, and an executed declaration naming Tim Keith, Randall Little, Paul Van Eerdewegh, Josee Dupuis, Richard Del Mastro, Jason Simon, Kristina Allen, and Sunil Pandit as joint inventors signed by all joint inventors except Pandit on behalf of themselves and joint inventor Pandit. The present petition asserts that a copy of the application was sent to joint inventor Pandit via Federal Express on two occasions, but that joint inventor Pandit has not signed and returned the declaration.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee; and
- (4) a statement of the last known address of the non-signing inventor.

The petition lacks item (2). In regards to item (3). The declaration does not state the citizenship of the non-signing inventor.<sup>3</sup> A statement of the inventor's citizenship is a statutory requirement and cannot be waived.<sup>4</sup> A new oath or declaration, signed by all of the signing inventors on behalf of themselves and the non-signing inventor in compliance with 37 CFR 1.63 and 1.67 is required. Additionally, the declaration submitted with the present petition is defective in that it contains non-initialized and/or non-dated changes.<sup>5</sup> It is also noted that the declaration states that applicants are claiming the benefit under 35 U.S.C. § 119(e) to Application No. 09/548,797. The benefit under 35 U.S.C. § 119(e) can only be

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<sup>2</sup>As 25 November, 2001, fell on Sunday, this petition was timely filed.

<sup>3</sup>MPEP 605.01.

<sup>4</sup>35 U.S.C. § 115, MPEP 605.01.

<sup>5</sup>MPEP 602.01. See 37 CFR 1.52(c).

claimed to a provisional application, and the application listed, No. 09/548,797, is not a provisional application. A new oath or declaration in compliance with 37 CFR 1.63 and 1.67 is required with any renewed petition. Lastly, it noted that joint inventor Del Mastro has indicated his citizenship is "British". This is not an appropriate citizenship designation. Office PALM records will indicate that joint inventor Del Mastro is a citizen of the United Kingdom.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents  
Box DAC  
Washington, D.C. 20231

By FAX: (703) 308-6916  
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23  
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Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.



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for Patent Examination Policy